

**R E M A R K S**

Claims 1 - 16 are pending and stand rejected. The Examiner has made a number of rejections based on Donson ('931 patent) and Grill (Ser. No. 600,244). In addition, the Examiner has raised double patenting rejections and formal rejections of the claims.

**A. There Is A Serious Flaw In The Examiner's Analysis**

The '931 patent has a filing date of July 31, 1992. The July 31, 1992 filing was a continuation-in-part of 600,244. Continuation-in-part applications often differ from a parent application because of the addition of new matter. In certain circumstances, they also differ in that information in the parent has been deleted - as is the case here. The Examiner has apparently assumed that the contents of the 600,244 application relied on by the Examiner for the rejections are reflected in the '931 patent. Interestingly, the contents have not remained the same; there has been a "hiatus of disclosure."

In order for the '931 patent to be entitled to the filing date of the 600,244 [for purposes of 102(e)], it must be shown that there has been "continuing disclosure through the chain of applications, without hiatus." *In re Schneider*, 481 F.2d 1350, 1356, 179 USPQ 46, 50 (CCPA 1973). Unfortunately, it appears that the specification of the 600,244 was significantly changed, with entire sections and examples deleted from the specification when the specification for the '931 application was prepared.

In this regard, the Examiner is requested to note that the '931 patent does not contain numbered examples beyond Example 16. And yet, the Examiner notes in the Office Action that the Examiner is relying on the contents of Examples 17 and 28 from the 600,224 specification (Office Action, p.6).

The Examiner also relies on Examples 1-4 of the 600,224 specification. However, it appears that these examples have been replaced with other examples in the '931 specification.

The Examiner relies in part on the list of viruses on page 12 of the 600,224 specification. However, this list has been changed in the '931 specification (see col. 9).

There are other changes as well. As noted in a previous response, "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with

evidence or argument shifts to the applicant . . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Here, the Examiner has not shown the requisite continuity of disclosure.

**1. The 600,244 Application Was Abandoned And Is Not 102(e) Art**

The hiatus of disclosure breaks the chain between the 600,244 application and the '931 patent. Moreover, since the 600,244 application was abandoned (and never matured into an issued patent), it cannot be used itself as 102(e) art. Nor can it be used to support a 102(e) rejection based on the '931 specification, unless the Examiner shows that the relied upon material is present in both specifications.

**2. The '931 Patent Does Not Enjoy The 600,244 Filing Date**

Since entire examples and sections of the 600,244 application were deleted or changed, the '931 patent does not enjoy the filing date of the parent. The Examiner has not made the requisite showing that the relied upon material is present in both specifications.

**3. The 600,244 Application Does Not Teach The Embodiment Claimed**

To further the prosecution, but without waiving the right to prosecute the unamended claims (or similar claims) in the future, the claims have been amended to specify the embodiment wherein the foreign peptide is from an animal virus. The Examiner has not shown the teaching of this element in the 600,244 Application (see the previously submitted Declaration of Dr. Rasochova), let alone that such a teaching was retained - and not deleted - from the '931 specification. The Examiner's admissions of what the '931 patent does NOT teach (Office Action, p. 14) are very relevant in this regard.

**B. The Other Rejections Must Fail**

The Examiner makes obviousness rejections based on combinations of the '931 patent with the 600,244 specification (as well as with other art). First, the 600,244 specification cannot be combined with anything - it is not prior art; moreover, its contents were not retained and the 600,244 application was abandoned. Second, the '931 patent is not 102(e) art until the Examiner establishes a relevant teaching in the 600,244 application which is retained in the '931 specification. Thirdly, and most importantly, the deficiencies in the '931 specification can not be remedied by using the deleted teachings of the 600,244 specification.

**C. Double Patenting**

The Examiner has rejected Claims 9-16 under the judicially created doctrine of double patenting over claims 1-9 of U.S. Patent 5,874,087 stating that the claims are not patentably distinct over the claims of the '087. The Applicants respectfully disagree.

Nonetheless, provided Applicants' claims are otherwise found allowable, Applicants may split out Claims 9-16 into a separate application with the required Terminal Disclaimer. This would permit Claims 1-8 to issue. The Examiner is requested to call the undersigned prior to another Office Action in order to discuss this procedure.

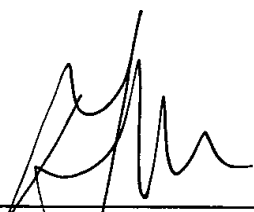
**D. Formalities**

The status of the claims (Presently Amended, Cancelled etc.) is now indicated pursuant to the revised 37 CFR §1.121.

**CONCLUSION**

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.252.3353.

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